

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. BELL, TIMOTHY R. CULP,
JOHN B. DALY, and MICHAEL HATTERMANN

Application No. 10/719,203

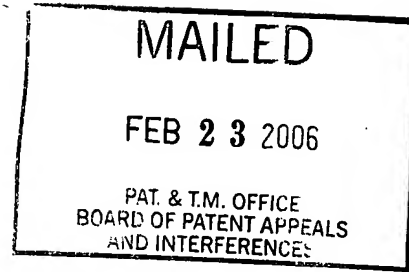
ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on January 18, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the file indicates that the appeal brief filed June 13, 2005 does not fully comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need



only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following appropriate sections are missing from the appeal brief filed June 13, 2005:

- 1) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

A supplemental appeal brief that is in compliance with the headings as set forth under 37 CFR § 41.37 are required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

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<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Furthermore, the examiner's answer mailed on July 28, 2005 does not comply with the headings as set forth in the new rules under 37 CFR § 41.37(c).

In addition, the final rejection mailed January 28, 2005 lists three statement of rejections: (1) claims 1-3, 9-14, 19-21 as rejected under 35 U.S.C. § 102(b) as being anticipated by Kimura (2001/0056326), (2) claims 4-8, 14-18, 22-25 as rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimura (2001/0056326), and (3) claims 8, 18 and 25 as rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimura (2001/0056326) in view of Satoh et al. (6,473,678) (see pp. 2-4). A review of the file reveals that the examiner's answer statement of rejections to claims 1-25 differ from the statement of rejections in the final rejection (see pp. 3-5). Before further review, the examiner must provide clarification to the statement of rejections to claims 1-25.

Accordingly, it is


ORDERED that this application be returned to the examiner to: 1) hold the appeal brief of June 13, 2005 defective; 2) request appellants to file a supplemental appeal brief in compliance with 37 CFR § 41.37 or to submit a statement

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from the examiner regarding the position taken on the missing appendices; 3) consider the supplemental appeal brief; 4) vacate the examiner's answer and file a revised examiner's answer in compliance with the new rules effective September 13, 2004 and in response to the supplemental appeal brief; 5) provide clarification of the statement of rejections to claims 1-25; and 6) for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

Craig R. Feinberg
Program and Resource Administrator
(571) 272-9797

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cc: Allen, Dyer, Doppelt, Milbrath & Gilchrist P.A.
1401 Citrus Center 255 South Orange Avenue
P.O. Box 3791
Orlando, FL 32802-3791

CRF/tdl